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OFFICE OF PETITIONS

In re Application of
Joshi
Application No. 09/649,563
Filed: 28 August, 2000
Attorney Docket No.: 98125CP01

ON PETITION

This is a decision on the untitled pleading filed on 10 April, 2002 (but not sufficiently supplemented until 4 June, 2002), presented: "[t]his is in response to the Decision on the prior petition under 37 C.F.R. §1.81 (sic)¹ of the above identified application * * *," and seeking reconsideration of the Decision of 22 January, 2002 (the January 2002 Decision), dismissing the pleading filed on 15 October, 2001.

As with the January 2002 Decision, despite Petitioner's mischaracterizations, this is properly

¹ The petition variously, and incorrectly, refers to "37 C.F.R. §1.81" and "37 C.F.R. §1.18." These citations clearly are inappropriate.

The regulations at 37 C.F.R. §1.81 address the issue of drawings, and provide:

§1.81 Drawings required in patent application.

(a) The applicant for a patent is required to furnish a drawing of his or her invention where necessary for the understanding of the subject matter sought to be patented; this drawing, or a high quality copy thereof, must be filed with the application. Since corrections are the responsibility of the applicant, the original drawing(s) should be retained by the applicant for any necessary future correction.

(b) Drawings may include illustrations which facilitate an understanding of the invention (for example, flow sheets in cases of processes, and diagrammatic views).

(c) Whenever the nature of the subject matter sought to be patented admits of illustration by a drawing without its being necessary for the understanding of the subject matter and the applicant has not furnished such a drawing, the examiner will require its submission within a time period of not less than two months from the date of the sending of a notice thereof.

(d) Drawings submitted after the filing date of the application may not be used to overcome any insufficiency of the specification due to lack of an enabling disclosure or otherwise inadequate disclosure therein, or to supplement the original disclosure thereof for the purpose of interpretation of the scope of any claim.

[43 Fed. Reg. 4015, Jan. 31, 1978; para. (a), 53 Fed. Reg. 47809, Nov. 28, 1988, effective Jan. 1, 1989]

The regulations at 37 C.F.R. §1.18 address the issue of fees, and provide:

§1.18 Patent post allowance (including issue) fees.

(a) Issue fee for issuing each original or reissue patent, except a design or plant patent:

By a small entity (§ 1.27(a))...\$640.00; By other than a small entity ...\$1,280.00

(b) Issue fee for issuing a design patent:

By a small entity (§ 1.27(a))...\$230.00; By other than a small entity\$460.00

(c) Issue fee for issuing a plant patent:

By a small entity (§ 1.27(a))...\$310.00; By other than a small entity\$620.00

(d) Publication fee\$300.00

(e) For filing an application for patent term adjustment under § 1.705.....\$200.00

(f) For filing a request for reinstatement of all or part of the term reduced pursuant to § 1.704(b) in an application for patent term adjustment under § 1.705\$400.00

[Added, 47 Fed. Reg. 41273, Sept. 17, 1982, effective Oct. 1, 1982; 50 Fed. Reg. 31824, Aug. 6, 1985, effective Oct. 5, 1985; revised, 54 Fed. Reg. 6893, Feb. 15, 1989, effective Apr. 17, 1989; revised, 56 Fed. Reg. 65142, Dec. 13, 1991, effective Dec. 16, 1991; paras. (a)-(c), 57 Fed. Reg. 38190, Aug. 21, 1992, effective Oct. 1, 1992; revised, 59 Fed. Reg. 43736, Aug. 25, 1994, effective Oct. 1, 1994; amended, 60 Fed. Reg. 41018, Aug. 11, 1995, effective Oct. 1, 1995; amended, 61 Fed. Reg. 39585, July 30, 1996, effective Oct. 1, 1996; amended, 62 Fed. Reg. 40450, July 29, 1997, effective Oct. 1, 1997; amended, 63 Fed. Reg. 67578, Dec. 8, 1998, effective Nov. 10, 1998; revised, 65 Fed. Reg. 49193, Aug. 11, 2000, effective Oct. 1, 2000; heading revised and paras. (d)-(f) added, 65 Fed. Reg. 56366, Sept. 18, 2000, effective Nov. 17, 2000; para. (d) revised, 65 Fed. Reg. 57024, Sept. 20, 2000, effective Nov. 29, 2000; paras. (a)-(c) revised, 65 Fed. Reg. 78958, Dec. 18, 2000; paras. (a)-(c) revised, 66 Fed. Reg. 39447, July 31, 2001, effective Oct. 1, 2001]

considered as a request under 37 C.F.R. §1.181² to withdraw the holding of abandonment.

The petition under 37 C.F.R. §1.181 is **GRANTED**.³

The petition under 37 C.F.R. §1.18 is **DISMISSED as inappropriate and therefore moot**.

And the petition under 37 C.F.R. §1.81 is **DISMISSED as inappropriate and therefore moot**.

BACKGROUND

A review of the record reveals that:

- the instant application was filed on 28 August, 2000;
- on 17 October, 2000, the Office mailed a Notice of Missing Parts, requiring that the statutory fee, funds for additional claims and a properly signed oath or declaration and the late-filing surcharge be filed within two months (i.e., on or before 17 December, 2000);
- Petitioner did not respond timely to the Notice of Missing Parts, and the application went abandoned after midnight 17 December, 2000;
- no Notice of Abandonment was mailed;
- on 15 October, 2001, Petitioner filed the original petition, which was dismissed in the January 2002 Decision, and which Decision noted therein that as of that writing Petitioner had failed to:

--pay the basic filing fee or the fee for additional claims, and

--file the executed oath or declaration,

² The regulations at 37 C.F.R. §1.181 provide, in pertinent part:

§1.181 Petition to the Commissioner.

(a) Petition may be taken to the Commissioner: (1) From any action or requirement of any examiner in the *ex parte* prosecution of an application which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court; (2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Commissioner; and (3) To invoke the supervisory authority of the Commissioner in appropriate circumstances. * * *

(b) Any such petition must contain a statement of the facts involved and the point or points to be reviewed and the action requested. Brief or memoranda, if any, in support thereof should accompany or be embodied in the petition; and where facts are to be proven, the proof in the form of affidavits or declaration (and exhibits, if any) must accompany the petition.

(c) When a petition is taken from an action or requirement of an examiner in the *ex parte* prosecution of an application, it may be required that there have been a proper request for reconsideration (§1.111) and a repeated action by the examiner. The examiner may be directed by the Commissioner to furnish a written statement, within a specified time, setting forth the reasons for his decision upon the matters averred in the petition, supplying a copy thereof to the petitioner.

(d) Where a fee is required for a petition to the Commissioner the appropriate section of this part will so indicate. If any required fee does not accompany the petition, the petition will be dismissed. * * *

(f) Except as otherwise provided in these rules, any such petition not filed within 2 months from the action complained of, may be dismissed as untimely. The mere filing of a petition will not stay the period for reply to an Examiner's action which may be running against an application, nor act as a stay of other proceedings. * * *

³ Pursuant to Petitioner's authorization:

- the small entity basic filing fee (\$370.00) and the surcharge for additional claims (\$18.00) are charged to Deposit Account 50-0545; and\
- the large surcharge (\$130.00) for late filing of the oath/declaration and late payment of the basic filing fee is refunded and the small surcharge (\$65.00) is charged to Deposit Account 50-0545.

as set forth in the Notice to File Missing Parts of 17 October, 2000;

- the instant petition was filed with:

- a statement by Jody Factor (Reg. No. 34,157);

- a copy of a Request for Customer Number Data Change for Customer Number 22876 dated 25 January, 2001 (Exhibit A)--notably, however, Petitioner ignored the request of the January 2002 Decision for a statement as to the effective date of Petitioner's move from the former West Monroe St. address to the new location at West Washington Blvd.;⁴

- a copy of a the Office acknowledgment via Notice of Customer Number Record Change, mailed on 7 February, 2001 (Exhibit B);

- a copy of a three- (3-) page "Actions Due - Done" list from Petitioner's Case Tracking System dated 5 April, 2002 (Exhibit C);

- a copy of a seven- (7-) page "Reminder List With Completed Items" list from Petitioner's Case Tracking System dated 8 April, 2002 (Exhibit D);

- a copy of a two- (2-) page "U.S. Patent Case Detail Report" for Petitioner's Docket Number MIC-981341 from Petitioner's Case Tracking System dated 5 April, 2002 (Exhibit E);

- a copy of a two- (2-) page "U.S. Patent Case Detail Report" for Petitioner's Docket Number MIC-98125CP01 from Petitioner's Case Tracking System dated 5 April, 2002 (Exhibit F);

- a copy of a one- (1-) page "Patent Office Action Report" for Petitioner's Docket Number MIC-98125CP01 from Petitioner's Case Tracking System dated 5 April, 2002 (Exhibit G);

- a copy of a one- (1-) page "Patent Office Action Report" for Petitioner's Docket Number MIC-981341 from Petitioner's Case Tracking System dated 5 April, 2002 (Exhibit H); and

- while Petitioner acknowledged receipt of the Notice to File Missing Parts via FAX on 27 September, 2001, upon filing the petitions of 15 October, 2001, and 10 April, 2002, Petitioner submitted neither the basic filing fee, nor the surcharge for additional claims, nor the signed oath or declaration (all of which were subjects of the Notice to File Missing Parts), and did not cure this void until the filing via FAX of a supplement on 4 June, 2002, containing therein *inter alia*:

- the signed oath or declaration, with a claim for small-entity status, and

- authorization for payment of the basic filing fee and surcharge for additional claims;

⁴ January 2002 Decision, at page 4.

- moreover, while Petitioner continues in his 4 June supplement to place the date of the Notice of Missing Parts at 27 October, 2001, the record clearly demonstrates that it was mailed on 17 October, 2000.⁵

Finally, the instant petition also refers (as did the original petition) to a "petition fee of \$130.00," previously paid. However, as noted in the January 2002 Decision,⁶ upon receipt of the payment the Office attributed those funds to Petitioner's prior liability for which the payment might most appropriately be allocated, to wit: the previously unpaid surcharge (for late filing of the oath or declaration and the late payment of the basic filing fee and surcharge for excess claims).

The courts have determined the construct for properly supporting an allegation of non-receipt of an Office action in seeking withdrawal of a holding of abandonment.⁷

In view of the statement of Counsel, the copy of the incoming-mail logs, Petitioner has demonstrated initial non-receipt of the Notice to File Missing Parts.

Accordingly:

- the petition to withdraw the Holding of Abandonment is **granted**;
- the holding of Abandonment is **withdrawn**;
- it is unnecessary to vacate the Notice of Abandonment because none was mailed; and
- the petition fee is **waived**.

In addition, the petitions under 37 C.F.R. §1.18 and §1.81 are **dismissed as inappropriate and therefore moot**.

This application is being forwarded to OIPE for processing as necessary (with attention drawn to the newly submitted claim for small entity status) before being forwarded for examination in due course.

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 305-9199.



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for Patent Examination Policy

⁵ "Additional Statement * * *," page 2, item 7.

⁶ See: Fn. 2 of the January 2002 Decision.

⁷ See: Delgar v. Schulyer, 172 USPQ 513 (D.D.C. 1971).